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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,271	09/23/2003	Frank Baumann	13321-C1	6581
7590 09/23/2004 KALOW & SPRINGUT LLP 488 MADISON AVENUE , 19th FLOOR NEW YORK, NY 10022			EXAMINER LANGEL, WAYNE A	
			ART UNIT	PAPER NUMBER
			1754	
DATE MAILED: 09/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.



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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. <u>17</u>
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ day(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 14-29 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 14-29 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 17-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either European 354664 or Japanese 59-82946.

European 354664 and Japanese 59-82946 both disclose catalysts comprising finely divided aluminum oxide and at least one element selected from a list of elements which include iron, cerium, platinum and palladium. (See the Abstract of each reference.)

Claims 14 and 17-28 are considered to be anticipated by European

354664 and Japanese 59-82946, since one of ordinary skill in the art could at once envisage the particular combination of elements as recited in applicant's claims 14 and 17-28. In any event, it would be prima facie obvious to select platinum, palladium, iron and cerium oxide as the catalytic components on the finely divided aluminum oxide support material for the catalysts of European 354664 and Japanese 59-82946, since it would be within the skill of one of ordinary skill in the art to determine suitable combinations of elements from the lists disclosed in the references to employ for the intended purpose. Regarding claims 24 and 25, a part of the catalysts of the references is considered to constitute a "first shift catalyst", and a second part is considered to constitute a "second shift catalyst".

Claims 14 and 17-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese 59-127649. Japanese 59-127649 discloses a catalyst comprising alumina supporting cerium, iron and platinum or palladium. (See the English Abstract.) The difference between the catalyst disclosed by Japanese 59-127649, and that recited in applicant's claims 14 and 17-28, is that Japanese 59-127649 does not specifically disclose that the catalyst contain both platinum and palladium. It would be prima facie obvious to include both platinum and palladium in the catalyst of Japanese 59-127649, since it would be obvious that if

either one of platinum or palladium would function in the catalyst, that the combination of both platinum and palladium would also function.

Claims 14 and 17-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ono et al. '895. Ono et al. '895 discloses a catalyst comprising iron, cerium, platinum and palladium (column 4, lines 51-60) on a finely divided aluminum oxide support (paragraph bridging columns 1 and 2).

Claims 14-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Durand et al. '403. Durand et al. '403 disclose a catalyst comprising a monolithic structure (column 1, lines 14-22) having coated thereon (column 2, lines 18-29) a catalyst comprising aluminum oxide (column 4, lines 9-14) and cerium oxide, iron oxide, platinum and palladium (column 4, lines 15-58). Claims 14-29 are considered to be anticipated by Durand et al. '403, since one of ordinary skill in the art could at once envisage the particular combination of elements recited in applicant's claims. In any event, it would be prima facie obvious from Durand et al. '403 to employ the specific combination of elements as recited in applicant's claims, since Durand et al. '403 clearly suggest that such combination would be operable as a catalyst, in view of the aforementioned passages.

Claims 14-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ono et al. '598. Ono et al. '598 discloses a catalyst comprising a monolithic honeycomb carrier having supported thereon aluminum oxide in combination with at least one metal selected from the group consisting of iron and nickel, cerium, and at least one metal selected from the group consisting of platinum, palladium and rhodium. (See column 2, lines 9-56.)

Claims 14-29 are considered to be anticipated by Ono et al. '598, since one of ordinary skill in the art could at once envisage from Ono et al. '598 the specific combination of elements as recited in applicant's claims. In any event, it would be prima facie obvious to select the specific combination of elements as recited in applicant's claims for the catalyst of Ono et al. '598, since it would be obvious from column 2, lines 9-56 of the reference that such combination would be useful as the catalyst disclosed therein.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an

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application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Durand et al. '481. Durand et al. '481 discloses a catalyst comprising a monolithic structure having deposited thereon aluminum oxide and a catalytic component comprising iron oxide, cerium oxide, and another metal which may include platinum and palladium. (See column 2, line 14 - column 3, line 65.) Claims 14-29 are considered to be anticipated by Durand et al. '481, since one of ordinary skill in the art could at once envisage the particular combination of elements as recited in applicant's claims. In any event, it would be prima facie obvious to employ platinum and palladium as catalytic components in the catalyst of Durand et al. '481, since it would be obvious from the sentence bridging columns 2 and 3 of the reference that platinum and palladium would function in the catalyst.

Claims 14-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Blanchard et al. '319. Blanchard et al. '319 discloses a catalyst comprising cerium, iron, platinum and

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palladium supported on aluminum oxide particles which are coated onto a ceramic monolith. (See column 2, line 3 - column 3, line 45.)

Claims 18-23 and 28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18-20 are indefinite in reciting method limitations (i.e., "the catalyst operates . . ."). It is well-settled that method limitations are improper in composition claims. Claim 28 is indefinite in that it is unclear as to whether the recited "method" would necessarily be the shift reaction, or whether it could be any method for which the catalyst might be employed.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,723,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are broader than the claims recited in Patent 6,723,298.

The other references are made of record for disclosing various catalysts which include aluminum oxide, platinum, palladium, iron and/or cerium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne A. Langel whose telephone number is (571) 272-1353. The examiner can normally be reached on Monday through Friday from 8 A.M. to 3:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (571) 272-1358. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status

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information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WAL:cdc

September 16, 2004


WAYNE A. LANGEL
PRIMARY EXAMINER